

REMARKS

Claims 16 to 30 are now pending.

Applicants respectfully request reconsideration of the present application in view of this Supplemental/Replacement Response (which supplements/replaces the Amendment mailed on June 13, 2007).

Reconsideration is respectfully requested based on the following.

Applicants thank the Examiner for acknowledging the claim for foreign priority and for indicating that all certified copies of the priority documents have been received.

To facilitate matters, enclosed are courtesy copies of the references referred to in the Notice of Non-Compliant Amendment. It is respectfully requested that the Examiner consider all such references, and acknowledge their consideration, consistent with U.S.P.T.O. practice and the MPEP.

It is first noted, however, that it is not proper to refuse to examine an amendment because it is asserted (wrongly) that copies of the references were not submitted -- since they are to have been provided by the International Searching Authority. In any case, the amendment is simply examined and any "missing" references (there were no "missing" reference here) are not made of record.

As regards the Search Report filed October 1, 2004, it was a European (and not a U.S.) search report, and therefore applies different standards. Still further, it considered original claims 1 to 15 and not new claims 16 to 30 (which generally correspond to original claims 1 to 15).

Nevertheless, copies of the three references are again provided, together with the following further remarks:

The Office Action originally stated that two documents were missing from the IDS submitted September 2, 2004. Applicants respectfully submit that the documents DE19639424 and DE 10015114 were cited in the Search Report provided by the International Searching Authority and therefore should have been provided by the International Searching Authority. However, courtesy copies of the documents accompanied the Amendment mailed on June 13, 2007 (and filed on June 18, 2007). Nevertheless, this Replacement Amendment includes further copies of these references.

With respect to Notice of Non-Compliant Amendment, it objected (for the first time and wrongly) because the Bertram article "The Safety Related Aspect of Cartronic" was assertedly missing from the IDS submitted September 2, 2004.

In this regard, according to M.P.E.P. § 1893.03(g), "[a]s a result of an agreement among the European Patent Office (EPO), Japan Patent Office (JPO), and the United States Patent and Trademark Office (USPTO), copies of documents cited in the international search report issued by any one of these International Searching Authority Offices generally are being sent to the other Offices when designated in the international application." *Accordingly, in United States national stage applications where the international search was conducted by the EPO, JPO, or USPTO, copies of the documents cited in the international search report are made available to the examiner in the national stage application, so that the applicant need not provide such copies and is not required to provide such copies. Nevertheless, this Replacement Amendment includes a copy of this reference.*

In sum, to facilitate matters, enclosed are courtesy copies of the subject foreign references. It is respectfully requested that the Examiner consider all such references, and acknowledge their consideration, consistent with U.S.P.T.O. practice and the MPEP.

Claim 27 has been rewritten to remove the term CARTRONIC. Withdrawal of the § 112, second paragraph, rejection is respectfully requested.

Claims 16 to 30 were rejected under 35 U.S.C. § 101 as assertedly directed to non-statutory subject matter.

Applicants submit that claim 16 provides a useful, concrete and tangible result. M.P.E.P. § 2106 states that while "abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods . . . employing abstract ideas, natural phenomena, and laws of nature to **perform a real-world function may well be**" (emphasis added). The method according to claim 16 produces a useful, concrete and tangible result to constitute a practical application of an abstract idea, law of nature or natural phenomena. As stated in M.P.E.P. § 2106, "the focus is not whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather on whether the final result achieved . . . is 'useful,

tangible, and concrete.” Claim 16 refers to performing a safety analysis. Thus, performing the features recited in claim 16 provides a safety analysis as a final result.

For a claim to be “useful,” it must satisfy the utility requirement, i.e., specific, substantial and credible utility must be provided. Applicants respectfully submit that a safety analysis is a useful result and may be used in at least one practical application, as explained below.

For a claim to satisfy the “tangible” requirement, the claim must set forth a practical application of that judicial exception to produce a real-world result. Applicants respectfully submit that a safety analysis has at least one practical application: evaluating safety of motor vehicle systems.

For a claim to satisfy the “concrete” requirement, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. Applicants respectfully submit that, given the same inputs, claim 16 will produce the same safety analysis in a repeatable manner.

Based on this analysis as set forth in M.P.E.P. § 2106, it is plainly apparent that claim 16 constitutes eligible subject matter. As such, withdrawal of this rejection is respectfully requested.

Similarly, independent claims 25, 28, 29 and 30 provide similar safety analysis of systems, and therefore also produce useful, tangible and concrete results. Claims 17 to 24 depend from claim 16 and claims 26 to 27 depend from claim 25, and are therefore allowable for at least the same reasons as explained above.

Claims 16 to 24 and 28 to 30 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,816,798 to “Pena-Nieves et al.”

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

In particular, in rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Applicants respectfully submit that the “Pena-Nieves” reference does not describe the features of “determining errors as a function of the functional structure” and “analyzing error dependencies **with respect to the functional structure**”, as provided for in the context of claim 16. The “Pena-Nieves” reference merely refers to analyzing and displaying reliability data from a user, but wholly fails to describe the feature of performing any determining or analyzing on a **functional structure**, as provided for in the context of claim 16. The “Pena-Nieves” reference merely refers to reliability information, and nothing indicates that reliability information may be in a functional structure.

Similarly, independent claims 28, 29 and 30 include features like those of claim 16 and are therefore allowable for essentially the same reasons as claim 16.

Claims 17 to 24 depend from claim 16 and are therefore allowable for at least the same reasons as explained above.

In summary, all pending claims are allowable.

Attorney Docket No. 10191/3800
U.S. Patent Application No. 10/506,372
Replacement/Substitute Amendment to
Reply to Notice of September 12, 2007 & to
Further Reply to Office Action of March 29, 2007

CONCLUSION

In view of the foregoing, all pending claims are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,
KENYON & KENYON LLP

Dated: 12/11/2007

By: 

Gerard A. Messina
(Reg. No. 35,952)

One Broadway
New York, NY 10004
(212) 425-7200

CUSTOMER NO. 26646

33,865
Aaron C.
DEDITCH

1453952